

REMARKS

Claims 1-36 stand rejected under 35 U.S.C. 112, second paragraph because “the proper size” and “the proper denomination” did not have sufficient antecedent basis. Independent claims 1, 7, 13, 19, 25 and 31 have been amended. They now refer to placing a gift or item or case of the predetermined size and no more than the maximum weight into one of the selected delivery boxes.

A question was also raised as to who actually performs the steps. It could be anyone, including any of those suggested by the examiner. The method was originally conceived for the purchaser of a gift item in a store to be able to purchase a delivery box for that gift, where the gift was of a standard size and or variable weight, such as jewel cases with one or two disks. In such a situation, there would be a maximum weight. The prepaid postage would be for the maximum weight. All that the gift buyer had to do was write in the address and enclose a card. It was then realized that this method could easily be adapted for many other situations. The method is clear enough without restricting it to just one type of user.

Finally, claims 1,6, 7, 12, 13, 18, 19, 24, 25, 30, 31, 36 and 37-39 stand rejected under 35 U.S.C. 102(e) based on the published patent application by Allen et al. (US 2005/0187885). The remaining claims are rejected under 35 U.S.C. 103 over Allen et al. (US 2005/0187885) in view of the published patent application of McClung et al. (US 2004/0059636).

Whereas claims can be rejected based on patents that issued after the filing date of an application, published patent applications must precede the date of invention in order to be good citations. In the present case, neither reference precedes the filing date of the current application, and therefore, cannot precede the date of invention. In the present case, the current application was filed long before the publication date of either of the cited published patent applications. In fact, the current patent application was filed on September 12, 2003 and the provisional application which led to the Allen et al. application was filed on August 14, 2003, less than one month difference. That would even raise a question if Allen et al. were an issued patent, because it would depend on what was in the original provisional application. The situation is even more complicated because the inventor of the current application had disclosed the information to one of the inventors of the Allen et al. application. Applicant does, therefore, request that an interference be declared either now or if and when the Allen et al. application issues. Please let the undersigned attorney know if and when he should copy claims from the Allen et al. application or patent.

A clean copy of the claims is enclosed.

It is believed that all of the claims are now in condition for allowance and an early

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indication of allowance is earnestly solicited. Since the number and type of claims remain unchanged, no additional fee is required. Please charge any additional fees which may be required or credit any over payment to Deposit Account No. 20-1123.

Respectfully,



W. Thomas Timmons
Registration No. 27,839
Customer No. 29222
1320 Prudential Drive
Suite 208
Dallas TX 75235-4117
Telephone 214-528-1881 Ext. 208
Facsimile 214-528-6578
timmons@ippractice.com